

Serial No. 09/944,110 Attorney Docket No. 12-006

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REMARKS

Claims 20, 21, 23, 24 and 26 – 28 are pending. Claims 1 – 19, 22, 25 and 29 – 31 have been canceled. Claims 24, 26, and 28 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

In the office action mailed August 4, 2005, claim 20 was objected to because of the format of the Markush grouping. Claim 20 has been amended as suggested in the office action. Withdrawal of the objection is respectfully requested.

Claims 20, 21, 23 and 27 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Specification, the examiner request applicant to point out the section of the specification that supports "and derivatives thereof" in claim 20. Claim 20 previously recited "the polymer material is at least one of the materials or the modified materials thereof, including polybenzimidazole ..." which was amended to "the polymer material is at least one material selected from the group consisting of polybenzimidazole... and derivatives thereof," in response to the examiner's previous objection. That is, the phrase "modified materials thereof" was amended to "derivatives thereof." By way of the above amendment, the specification has been amended to more clearly conform to the amended wording. Furthermore, claim 20 has been amended to more properly recite the polymer material with backbone chain, and the modifier with substituent. The examiner is therefore respectfully requested to withdraw the rejection under 35 USC 112, first paragraph.

Claims 20, 21, 23 and 27 were rejected under 35 USC 112, second paragraph, as being indefinite. The applicants respectfully request that this rejection be withdrawn for the following reasons.

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The phrase "substitutional group" has been amended to read "functional group."

With respect to the requirement to change "polymer material" to "modified polymer material," section 112, second paragraph requires that A) claims set forth subject matter applicants regards as the invention; and B) claims particularly point out and distinctly claim the subject matter of the invention. Since A) relies on subjective interpretation, B) necessarily forms the objective basis for a rejection under this paragraph. Item B) requires an inquiry into the definiteness of the claim, e.g. whether the scope of the claim would be clear to a person of ordinary skill in the art (MPEP 2171).

Applicants submit that since the claims would have been clear to one of ordinary skill in the art as written, an objection would have been a more appropriate means to address clarity issues. Since claim 20 recites that a portion of the polymer material "is modified by a modifier," the claim would be clearly understandable to one of ordinary skill as referring to a modified polymer material. Indeed, the office action states that this is so. Therefore the rejection is improper under 35 U.S.C. §112 second paragraph.

Without acknowledging the propriety of the rejection, applicants have amended the claims to expressly recited a "modified polymer material" to improve the clarity thereof. This amendment has been made as to matters of form only to address the Examiner's concerns relating to clarity and not for reasons related to patentability. Thus the scope of the amended claims has not been narrowed within the meaning defined in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002).

Claims 20, 21, 23 and 27 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,852,108, Yamanaka et al. ("Yamanaka"). The applicants respectfully request that this rejection be withdrawn for the following reasons:

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Independent claim 20, as amended, recites in combination "at least a portion of the modified polymer material is modified by a first modifier, the first modifier having at least two successive carbon atoms bonded to carbon atoms of the backbone chain and having a predetermined substituent different from the functional group of the modified polymer material, wherein said predetermined substituent is bonded to a second modifier having a -SiOSi- structure."

The office action asserts that Yamanaka discloses the invention as claimed. To the contrary, Yamanaka fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole. For example, Yamanaka fails to teach or suggest that a predetermined substituent is bonded to a second monidifer having a -SiOSi- structure.

Yamanaka fails to teach or suggest, for example, these elements recited in independent claim 20 as amended. It is respectfully submitted therefore that claim 20 is patentable over Yamanaka.

With respect to the rejected dependent claims, applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claim 20, but also because of additional features they recite in combination.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shown any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of

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simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



David G. Posz

Reg. No. 37,701

Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400